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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,991	11/20/2001	Gregory Luedtke	219002029100	1704
25225	7590	10/27/2004	EXAMINER	
MORRISON & FOERSTER LLP 3811 VALLEY CENTRE DRIVE SUITE 500 SAN DIEGO, CA 92130-2332			CHANG, CELIA C	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 09/989,991	<b>Applicant(s)</b> LUEDTKE ET AL.	
	<b>Examiner</b> Celia Chang	<b>Art Unit</b> 09/1	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

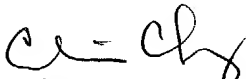
Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: Morrison and Boyd p.74

  
 Celia Chang  
 Primary Examiner  
 Art Unit 1625

Art Unit: 1625

*ATTACHMENT TO ADVISORY*

Amendment and response filed by applicants dated Sept. 17, 2004 will not be entered because it not only does not obviate the rejection but also introduced new matter. The following explanation is an exemplified discussion of the numerous new matter being introduced but is not an exhausted listing.


The deletion of such terms "heteroalkyl" "heteroalkenyl" "heteroalkynyl" or "noninterfering substituents" are proper. However, the deletion of "fused" with the editorial change made the scope of the claims confusing and is considered NEW MATTER. Although it is indefinite in absence of particularity of how and which two substituents forms what ring, but it is clear that when two adjacent moieties on a ring i.e. the Ar moiety, it becomes a "fused" ring. Applicants particularly removing of the fused ring and broadened the scope to be not necessarily fused, is NEW MATTER.

The arguments with respect to functional language can be employed to define claims is not the issue. Please note that since the claims are "compounds", it does not matter what language one uses, the "structure" of the chemical compounds must be defined. As it is exemplified above, even though attorney considered the amendments in the claims are just editorial, it is clearly explained that such arbitrary change resulted in a structural relationship which is completely new to the specification.

The attorney also argued that why the examiner mentioned the issue with size and structure and considered such being indefinite, and presented that one having ordinary skill in the art would considered alkylene or alkenylene each of 2-6 Å understood without difficulty. The confusing is "what" is the *scope* of the claims. Please note that a simple look into the organic textbook would evidenced that a single carbon to carbon chain length is 1.53 Å. So is alkylene having 2-6 Å at least two carbon? Then what is this moiety? One to 10 carbon as defined by alkylene or at least two carbon as defined by 2-6 Å? The ambiguity is self evident.

The method claim 68 being drawn to such enormity of conditions. Please note that in the previous office action, based on factual evidence of the prior art, only limited understanding and high unpredictability on the mechanistic function was known. In absence of nexus of any compounds to the "therapy" of such a long list of diverse disorders, the specification lacks description and enablement for such scope.

Please note that this action is not an exhausted listing of all the possible rejections of the amended claims since this is an after final amendment and only exemplified explanation is provided.

  
CEILA CHANG  
PRIMARY EXAMINER  
GROUP 1200